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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/493,487	01/28/2000	Andrew Sharp	34648/00430USPX	2310

7590 12/22/2003  
Jenkins & Gilchrist  
1445 Ross Avenue, Suite 3200  
Dallas, TX 75202

EXAMINER
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NGUYEN, TU X

ART UNIT	PAPER NUMBER
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2684

19

DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/493,487

Applicant(s)

SHARP ET AL.

Examiner

Tu X Nguyen

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's arguments with respect to claims 1-41, have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-19, 21-28, 38 and 40-41, are rejected under 35 U.S.C. 102(e) as being anticipated by Rasanen (US Pub. 2002/0045447).

Referring to claims 1-3, 15 and 40 Rasanen discloses a communication system comprising:

a UMTS network is capable of handling a first number of communications between a mobile user equipment (see par. 0047-0050),

a GSM network is capable of handling a second number of communications between a mobile user equipment (see par. 0047-0050), and

wherein at least one of the mobile user equipment and the communication (see par.0030) system contain

at least one means for evaluating if a handover between the UMTS material and GSM material should be effectuated (see par.0016) and

at least one means for selecting, in the case that the handover is necessary, which communication or communications are handed over (see par.046-054) and

at least one means for executing the at least one decision (see par.0047, 0054).

Regarding claim 41, Rasanen discloses everything as claim 1 above. More specifically, Rasanen discloses "plurality of sessions" and "which session" (see par.0046-0047), "set of services" reads on "plurality of sessions".

Regarding claims 4-5 and 8, Rasanen discloses at least one of the UMTS and GSM network contains the means for executing/making the at least one decision (see par.0048-0051).

Regarding claims 6, 9 and 19, Rasanen discloses the mobile user equipment contains the means for executing/making the at least one decision (see par. 0064-0066).

Regarding claims 10-11, Rasanen discloses means for making at least one decision whether an intersystem handover is necessary (see par.0054).

Regarding claim 12, Rasanen discloses the device is located in at least one of the UMTS and GSM network (see par.0035).

Regarding claim 13, Rasanen discloses the device is located in a radio network controller (see par. 0031-34).

Regarding claim 14, Rasanen discloses the device is located in a core network (see par.0032).

Regarding claims 16-17, Rasanen discloses the access network signals a core network, before the access network sends the handover query to the mobile user equipment (see par.0077).

Regarding claim 18, Rasanen discloses the core network adds information about a communication or communications which can be supported (see par. 0056 and par.0081-0086).

Regarding claims 21 and 23, Rasanen does not mention of holding connections during handover, therefore it is inherently that the mobile user equipment disconnects all connections that cannot be kept in the second access network.

Regarding claim 22, Rasanen discloses the core network decides which communication or communications should be handed over to the second access network (see par. 0045, 0081-86).

Regarding claim 24, Rasanen discloses mobile equipment would move between the first access network and the second access network depends on at least one presetting (see par.0054).

Regarding claim 25, Rasanen discloses the presettings are located within a mobile user equipment (see par.0064-074).

Regarding claims 26-28, Rasanen discloses the presettings are transferred to the core network within at least one of an initial user equipment message and in a setup message (see par.0077).

Regarding claim 38, Rasanen discloses the mobile user equipment contains an indicator that an intersystem handover is needed (see par.0066).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 29-34, are rejected under 35 U.S.C. 103(a) as being unpatentable over Rasanen.

Regarding claims 29-34, Rasanen fails to disclose the presettings can be different/identical for each mobile user. An Official notice is taken that It would have been obvious the concept million of mobile users some are different and some are identical and being categorized in database are well known in the art in order to provide more efficient network resources.

6. Claims 20, 35-37 and 39, are rejected under 35 U.S.C. 103(a) as being unpatentable over Rasanen and further in view of Byrne.

Regarding claim 20, Rasanen fails to disclose the mobile user equipment informs the access network about the communication or the communications which should be handed over to the second access network.

Byrne discloses the mobile user equipment informs the access network about the communication or the communications which should be handed over to the second access network (see col.8 lines 5-14). Therefore, It would have been obvious to one of

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ordinary skill in the art at the time the invention was made to modify the system of Rasanen with the above teaching of Byrne in order to provide effective handover procedure between networks.

Regarding to claims 35-37 and 39, Rasanen discloses everything as claim 1 above. However Rasanen fails to disclose "holding at least one of the communication before an intersystem handover; and maintaining said at least one of the communications on hold during and after the intersystem handover".

Byrne discloses "holding at least one of the communication before an intersystem handover; and maintaining said at least one of the communications on hold during and after the intersystem handover" (see abstract and col.8 lines 15-19). Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Rasanen with the above teaching of Byrne in order to ensure call drops during handover.

### Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu Nguyen whose telephone number is (703) 305-3427. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MAUNG NAY A, can be reached at (703) 308-7749.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 Customer Service Office at (703) 306-0377.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9314 (Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

  
NAY MAUNG  
SUPERVISORY PATENT EXAMINER

TN  
12/5/03